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15
16 **UNITED STATES DISTRICT COURT**
17 **SOUTHERN DISTRICT OF CALIFORNIA**
18

19 INFOGATION CORP.,

20 Plaintiff,

21 v.

22 ZTE (USA), INC.,

23
24 Defendant.

Consolidated Actions

Case Nos.: 16-cv-01901-H-JLB
17cv646-H-JLB

**PLAINTIFF INFOGATION CORP.'S
MEMORANDUM REGARDING THE
PRIORITY DATE OF U.S. PATENT
NO. 6,292,743**

1 INFOGATION CORP.,

2 Plaintiff,

3 v.

4 HTC CORPORATION and
5 HTC AMERICA, INC.,

6 Defendants.

Consolidated Actions

Case Nos.: 16-cv-01902-H-JLB
17-cv-645-H-JLB

7 INFOGATION CORP.,

8 Plaintiff,

9 v.

10 HUAWEI DEVICE USA, INC.,
11 HUAWEI DEVICE CO., LTD., and
12 HUAWEI DEVICE (DONGGUAN) CO.

13 Defendants.

Consolidated Actions

Case Nos.: 16-cv-01903-H-JLB
17-cv-647-H-JLB

1 Plaintiff InfoGation Corp. (“InfoGation”) hereby files its Memorandum Regarding
 2 the Priority Date of U.S. Patent No. 6,292,743 (“the ’743 patent”) as ordered by this
 3 Court on May 5, 2017.

4 **I. INTRODUCTION**

5 InfoGation is entitled to assert an earlier invention date in this action because 1) it
 6 complied with its obligations under the Patent Local Rules, 2) it provided information
 7 concerning an earlier priority date to Defendants shortly after discovering the Visteon
 8 Document, and 3) Defendants will not suffer prejudice.

9 **II. FACTUAL BACKGROUND**

10 **a. InfoGation’s search for documents pursuant to Patent L.R. 3.2(b)**

11 Pursuant to Local Rule 3.1 and the Scheduling Order entered by this Court on
 12 November 22, 2016, InfoGation served its Disclosure of Asserted Claims and
 13 Infringement Contentions (the “Infringement Contentions”) on December 2, 2016. Prior
 14 to that disclosure, and pursuant to Patent L.R. 3.2(b), InfoGation conducted an extensive
 15 search of its files for documents required to accompany the Infringement Contentions.
 16 The search for documents under Patent L.R. 3.2(b) was comprised of the following
 17 relevant efforts:

18
 19 i. InfoGation identified all repositories of documents that could
 20 potentially contain documents created on or before January 6, 1999
 21 (the ’743 patent’s filing date) that were associated with the ’743
 22 patent, including all folders and e-mails associated with the ’743
 23 patent on the hard drives of InfoGation’s CEO, Dr. Qing Kent Pu, all
 24 archived files associated with the ’743 patent located on InfoGation’s
 25 computer network, and all paper files associated with the ’743 patent.
See Pu Decl. at ¶ 3.

26 ii. InfoGation searched all of the identified repositories extensively for
 27 documents created on or before January 6, 1999 that evidence the
 28 conception, reduction to practice, design, and development of each
 claimed invention. Searching all of these files took approximately 16-
 20 hours. *See Pu Decl. at ¶ 4.*

1
2 Despite conducting this diligent search of its files, InfoGation was unable to locate
3 any documents created on or before the filing date of the application for the '743 patent
4 that evidenced the conception and reduction to practice, design, and development of the
5 claimed invention.

6 **b. InfoGation's search pursuant to Defendants' March 7, 2017 document**
7 **requests.**

8 On March 7, 2017, Defendants collectively served 17 interrogatories and 207
9 document requests on InfoGation. Included within these document requests were several
10 requests for numerous types of documents that may be associated with the named
11 inventors of the '743 patent. *See* Pennington Decl. Exs. A-C (Defendants' Document
12 Request Nos. 34, 35, 36, 37). To search for documents in response to these and other
13 requests, InfoGation broadened its search to cover all archived documents of Dr. Henry
14 Li, a former employee of InfoGation who left the company in March 2000 and a co-
15 inventor of the '743 patent. *See* Pu Decl. at ¶ 6. In this broader search of Dr. Li's files,
16 InfoGation located documents related to draft proposals created by InfoGation.¹
17 Specifically, InfoGation located a Microsoft Word document in Dr. Li's files bearing the
18 non-descript title "prop3" (the "Visteon Document"). *See* Pu Decl. Ex. 1.

19 **c. The Visteon Document.**

20 While the Visteon Document does not reference the '743 patent, its content clearly
21 supports an earlier conception date. Specifically, the key elements of claim 15 are
22 disclosed in the document. For instance, the "non-proprietary" limitation of claim 15 is
23 discussed in the document. One example is provided in section 1.4, which describes
24 InfoGation's vision for vehicle navigation comprising, *inter alia*, a system based on an

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26 ¹ In correspondence dated April 14, 2017 to opposing counsel, counsel for InfoGation
27 indicated that the Visteon document was found in a search for proposal files. For clarity,
28 while proposal files were searched for and located, the most appropriate characterization
of the search leading to the Visteon Proposal would be that it was a comprehensive
search of Dr. Li's files, which were found to contain draft proposal files.

1 “open platform,” contrasting it with U.S. and European platforms that are “proprietary.”
2 *See* Pu Decl. Ex. 1, at 6.

3 The “optimal route based on real time traffic information” limitation of claim 15 is
4 also discussed in the document. For example, section 2.2 refers to a dynamic route
5 planning system that uses “real-time traffic information.” *Id.* at 17. Section 2.2.2
6 describes navigation software that “will provide the capability to calculate a route based
7 upon periodic traffic information relayed through the wireless communication network.”
8 *Id.* at 17.

9 The “natural language” limitation is also discussed in the document. For example,
10 section 2.1.4.1 refers to navigation instructions using maneuver terms including but not
11 limited to “Enter,” “Exit,” “Bear left,” “Bear right,” “U turn,” “Roundabout,” and “Name
12 change.”. The turning type specifies the degree of turning that is required: “Straight”,
13 “Slight left”, “Left”, “Hard left”, “U turn”, “Hard right”, “Right”, and “Slight right”. *Id.* at
14 12.

15 **d. InfoGation’s Responses to Discovery Requests.**

16 InfoGation produced the Visteon Document to all Defendants in its first response
17 to each Defendants’ First Set of Requests for Production of Documents. *See* Pennington
18 Decl. at ¶ 5. Further, InfoGation identified the document in its first response to
19 Defendants’ Common Interrogatory No. 1 and identified the correct invention date of the
20 patent as January 21, 1998. *See* Pennington Decl. Ex. D.

21 **III. ARGUMENT**

22 **A. InfoGation’s is entitled to assert an earlier priority date.**

23 As a described above, InfoGation met its obligations under Patent L.R. 3.2(b) by
24 diligently searching for documents related to the conception and reduction to practice of
25 the ’743 patent. This effort was significant and included identifying document
26 repositories that included the CEO’s hard drive, the InfoGation employee network
27 archive, and paper files from the timeframe surrounding the filing of the ’743 patent.
28

1 Despite searching these files for a significant amount of time, InfoGation was unable to
2 locate documents that would support an earlier invention date.

3 The discovery of the Visteon Document only occurred when InfoGation, in
4 response to several broad document requests propounded by Defendants, extended its
5 search to a comprehensive review of all of Mr. Li's files and opened a Microsoft Word
6 document that provided no outward indication that it would be associated with the '743
7 patent technology or navigation systems; it was titled simply "prop3." After reviewing
8 the document and concluding that it supported an earlier invention date, InfoGation
9 produced the document in its first response to Defendants' First Set of Requests for
10 Production of Documents and identified the document and earlier conception date in its
11 first response to Defendants' First Set of Common Interrogatories.

12 The significant effort of InfoGation's initial search for documents responsive to
13 Patent L.R. 3.2(b), the obscure file identification associated with the Visteon Document,
14 and InfoGation's provision of the newly located information in its first responses to
15 Defendants' discovery requests all demonstrate that InfoGation's assertion of an earlier
16 invention date is made in good faith. In such circumstances, InfoGation should not be
17 precluded from relying on a document that clearly demonstrates an earlier date of
18 conception.

19 **B. Defendants cannot show prejudice.**

20 Defendants have been provided with ample time and opportunity to investigate
21 InfoGation's asserted priority date. Defendants received the Visteon Document and
22 InfoGation's interrogatory response identifying the earlier conception date well before
23 even noticing any depositions and with almost 6 months remaining in discovery.²
24 Further, Defendants cannot claim prejudice with respect to their invalidity contentions
25 because they already searched for and located prior art references that were publicly
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27 ² The Visteon document and InfoGation's Interrogatory Response regarding the invention
28 date of the patent were served on April 7, 2017, and April 6, 2017, respectively, which is
181 days from the close of fact discovery on November 3, 2017.

1 available before January 6, 1999, which would include all references that were publicly
2 available before January 21, 1998. In fact, they identified prior art references publicly
3 available prior to January 21, 1998 in their invalidity contentions. *See* Pennington Decl.
4 Exs. E-G (Defendants' amended invalidity contentions). Absent such prejudice,
5 Defendants cannot reasonably argue that InfoGation should not be afforded the
6 opportunity to assert an earlier invention date.

7 **IV. Conclusion**

8 For the foregoing reasons, InfoGation respectfully submits that it is entitled to
9 assert an earlier invention date in this action.

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11 DATED: May 12, 2017

KIRBY & KIRBY LLP,

13 By: /s/ Michael L. Kirby
14 Michael L. Kirby
15 Heather W. Schallhorn
16 Attorneys for Plaintiff InfoGation Corp.
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1 **PROOF OF SERVICE**

2 ***INFOGATION vs. HTC CORPORATION, et al.***

United States District Court, for the Southern District of California

3 **Consolidated Actions: Case No.: 16-cv-1902-H-JLB / 17-cv-645-H-JLB**

4 ***INFOGATION CORP. vs. ZTE CORPORATION, et al.***

United States District Court, Southern District of California

5 **Consolidated Actions: Case No. 3:16-cv-01901-H-JLB / 17-cv-646-H-JLB**

6 ***INFOGATION CORP. vs. HUAWEI TECHNOLOGIES CO., LTD.***

U.S. District Court, Southern District of California

7 Case No. 3:16-cv-01903-H-JLB / 17-cv-647-H-JLB

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9 The undersigned hereby certifies that a true and correct copy of the above and
10 foregoing document has been served on May 12, 2017, to all counsel of record who
11 are deemed to have consented to electronic service via the Court's CM/ECF system
12 per Civil Local Rule 5.4.
13

14 /s/ Julie A. Roland
15 Julie A. Roland
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